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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,930	11/03/2003	Michael J. Iaconis	06181-918001	5058
26171	7590	06/27/2006	EXAMINER	
FISH & RICHARDSON P.C.			LOWEN, ALYSSA	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	
			3711	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/698,930

**Applicant(s)**

IACONIS ET AL.

**Examiner**

Alyssa M. Lowen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 and 30 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 3/30/06. These drawings are unacceptable. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figs. 6A and 2B fail to comply with 37 CFR 1.84 (b)(1). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.
2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figs. 7A and 7B fail to comply with 37 CFR 1.84 (b)(1). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-5, 7-20, 22-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pin-Hung (4878875) and Suzuki (3199248). Pin-Hung discloses a

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toy having a body (Fig. 3), a motor or driving device (11) within the body (Fig. 4), an appendage (8) coupled to the body of the toy (Fig. 3) is actuated by the motor to move relative to the body along a first path (column 2 lines 10-25) that including movement of an end of the appendage along a non-circular path (column 4 lines 9-12) and a neck device (34) coupled to the body of the toy and actuated by the motor to move relative to the body along a third path (column 3 lines 2-8). A drive shaft operatively couples the motor to the appendage (Fig. 4). A cam or rotating device (31) receives the drive shaft such that rotation of the drive shaft rotates the cam (Fig. 4). An eccentric rod (82) to which the appendage connects extends from the cam (Fig. 6). A linkage rod (86) is coupled to the body of the toy and to a slot within the appendage and rotation of the cam causes the appendage to move along the first path (Fig. 6). The drive shaft further couples the motor to a neck device (Fig. 4). A head is connected to the neck device (Fig. 11), which includes a hinge (36) attached to the body such that the neck device is configured to rotate about the hinge as the neck device moves along the third path (Fig. 11). A follower (32) is attached to the neck device (Fig. 4) and coupled to the drive shaft by a cam (24) such that rotation of the drive shaft moves the follower in a periodic pattern and causes the neck device to move along the third path (column 3 lines 4-8). The toy has a controller in the form of a circuit (9) with a switch (101) located within the body and coupled to the motor (Fig. 12) and a sensor (10) connected to send a signal to the controller or circuit, which operates the motor in response to a signal from the sensor (column 2 lines 30-44). Another appendage shaped like the appendage is coupled to the body of the toy and positioned such that the ends of the appendages

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move in non-circular paths that are aligned with each other (Fig. 7). The toy also has a flexible skin cover (4) that resembles an animal's coat and surrounds the body and appendages of the toy (Fig. 1). The appendage is further actuated by the motor to rotate relative to the body about a first axis which runs horizontally through pin (96) and the neck device is further actuated by the motor to rotate relative to the body about a third axis that runs horizontally through hinge (36) making it parallel with the first axis. The device of Pin-Hung discloses the basic inventive concept, substantially as claimed with the exception of a moveable tail device. Suzuki discloses a toy animal device with appendages and a tail that move simultaneously with respect to one another (column 3 lines 23-26). The tail device (11) is coupled to the body of the toy (Fig. 3) and is actuated by a motor (2) to move relative to the body along a second path (Fig. 8). A drive shaft in the form of a crankshaft (3) couples the motor to the tail device (Fig. 3) and a connector piece (6) connects to a lower piece of a tail device to cause the tail to oscillate giving the appearance of a wagging tail (Fig. 3). It would have been obvious to one of ordinary skill in the art from the teaching of Suzuki to modify the device of Pin-Hung to include an oscillating tail in order to have a plurality of mechanisms moving in a timed relation so as to give a lifelike animation to the figure (column 3 lines 19-25). Regarding the limitation of a cam located on the drive shaft with a groove receiving the shaft of the connector piece, Pin-Hung discloses using cams on drive shafts having grooves formed between the lip of the pin on the cam and the cam itself that engage parts of the device such that rotation of the cam causes movement of the part (Fig. 6). The combination of Pin-Hung and Suzuki discloses a toy and a method of actuating a

toy where the appendage and neck are actuated by a motor and rotated about a first and third axis, respectively, that are parallel to one another and a tail device coupled to the body of the toy and actuated by the motor is rotated relative to the body about a second axis that is perpendicular with the first axis (Fig. 2).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pin-Hung and Suzuki and further in view of DeCesare (5876273). The device of Pin-Hung and Suzuki discloses the basic inventive concept substantially as claimed with the exception of a pivot gear coupled to the body of the toy and including a post that couples to a slot within the appendage, where gear teeth that mesh with gear teeth of the pivot gear extend from the cam such that rotation of the cam causes rotation of the pivot gear, which causes the appendage to move along the first path. DeCesare discloses a pivot gear (21) that includes a post for engaging a slot in an appendage and a cam or gear (22) engages the teeth the pivot gear (22) to cause the appendage to move along a first path (Fig. 2). The device of Pin-Hung and Suzuki uses a linkage rod coupled to the body as opposed to a pivot gear. However, these two elements are art-recognized functional equivalents in that they act to direct the movement of an appendage over a path. It would have been obvious to one of ordinary skill in the art to use a pivot gear to direct the movement of a part.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-20 and 22-47 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML



**EUGENE KIM  
SUPERVISORY PATENT EXAMINER**